



COHEN PONTANI LIEBERMAN & PAVANE

551 Fifth Avenue, New York, NY 10176 phone 212.687.2770 fax 212.972.5487 www.cplplaw.com

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From: Teodor J. Holmberg
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Notes/Comments:

PETITION UNDER 37 CFR §1.144
FROM REQUIREMENT FOR RESTRICTION
IN
U.S. PAT. APP. SER. No. 10/691,404

Contents: 8 pages of petition

**As indicated on the enclosed Petition,
please charge the \$130 Petition fee
(and any other required fees) to our
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Cohen, Pontani, Lieberman, and Pavane

Teodor J. Holmberg, Reg. No. 60,140

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MAR 01 2005

Attorney Docket # 4285-7

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Michael BRUNN

Serial No.: 10/691,404

Filed: October 21, 2003

For: Super Long Range Crash-Bang Round

Examiner: Nguyen, T. T.
Group Art: 3644I hereby certify that this correspondence is being
facsimile transmitted to the U. S. Patent and
Trademark Office (Fax No. (703) 872-9306)on March 1, 2005
(Date of Deposit)Teodor J. Holmberg
Name of applicant, assignee or Registered
Representative

Signature

March 1, 2005
Date of SignatureVia Facsimile: (703) 872-9306PETITION FROM REQUIREMENT OF RESTRICTION
UNDER 37 CFR §1.144

SIR:

Please charge \$130 for the filing of this petition to our Patent and Trademark Office Deposit Account No. 03-2412. It is believed that no additional fees or charges are required at this time in connection with the present application; however, if any additional fees or charges are required at this time, they also may be charged to our deposit account.

In the above-identified matter, a Restriction Requirement issued on April 27, 2004. A response traversing the Restriction Requirement and requesting that the Examiner reconsider the requirement under 37 CFR §1.143 was filed on May 27, 2004. In an Office Action dated September 13, 2004, the Examiner made the Restriction Requirement final. The Examiner issued a Final Rejection on February 2, 2005. Thus, this Petition is being filed under 37 CFR §1.144, as a final action has been taken on the elected claims and an appeal has yet to be filed ("Petition may be deferred until after final action on or allowance of claims to the invention elected, but must be filed not later than appeal"). This petition is being filed within one month of that final action.

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 Amdt. dated March 1, 2005
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STATEMENT OF FACTS

On October 21, 2003, U.S. Pat. App. Ser. No. 10/691,404 ("the application") was filed, claiming priority from U.S. Prov. Pat. App. Ser. No. 60/419,891. The invention described within related generally to shotgun ammunition, and particularly to a shotgun projectile capable of exploding with a loud noise and/or concussion, and producing low mass, low energy fragments which do not pose a serious risk of injury to persons close to the explosion. One use of such projectile is for crowd control where such a projectile would be launched from a shotgun and travel a certain distance before a flash charge within the projectile detonates above and/or around the crowd.

Different embodiments are described in the application, but each has a weighty and frangible ballast located on the leading edge of the projectile, where the weight helps provide stability and accuracy in flight, and the frangibility results in the ballast becoming low mass, low energy fragments after the flash charge is detonated. The application has pairs of drawings (one for the projectile, one for the cartridge, e.g., FIG. 4A shows the projectile, while FIG. 4B shows the projectile of FIG. 4A in the cartridge) for each of the various depicted embodiments. Below, find reduced reproductions of FIGS 4A/4B, 5A/5B, 6A/6B, and 7A/7B.

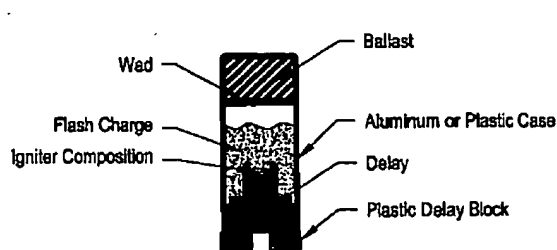


FIG. 4A
Crash-bang Projectile #1

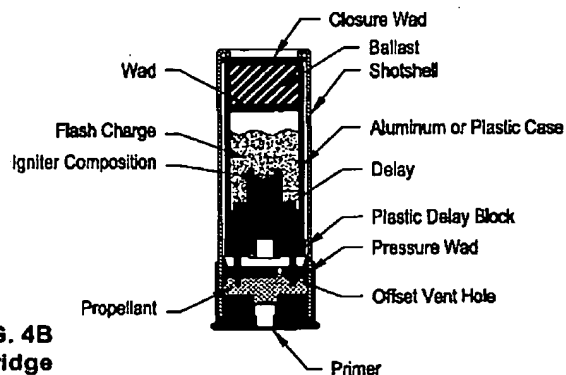


FIG. 4B
Projectile #1 in Cartridge

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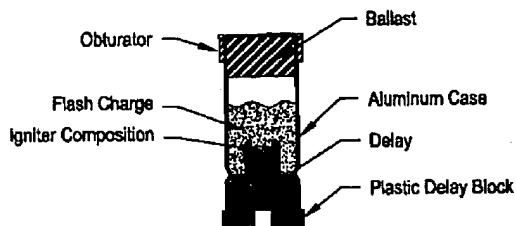


FIG. 5A
Crash-bang Projectile #2

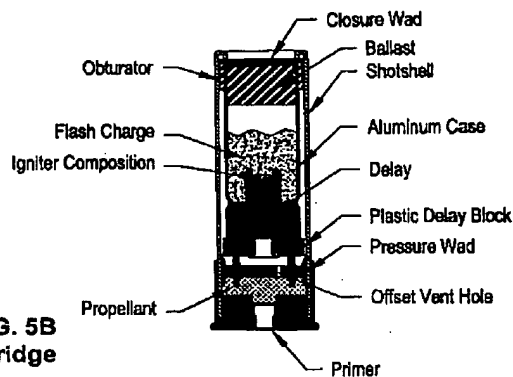


FIG. 5B
Projectile #2 in Cartridge

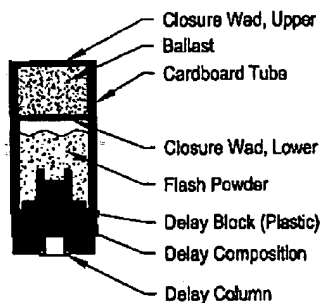


FIG. 6A
Crash-bang Projectile #3

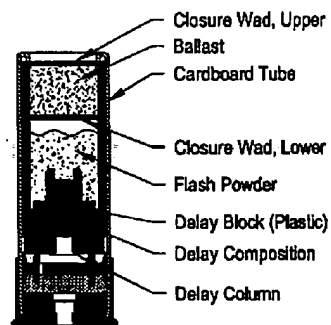


FIG. 6B
Projectile #3 in Cartridge

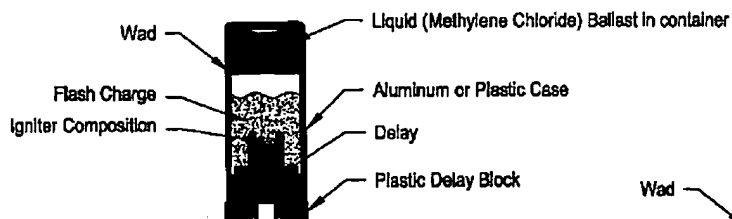


FIG. 7A
Crash-bang Projectile #4

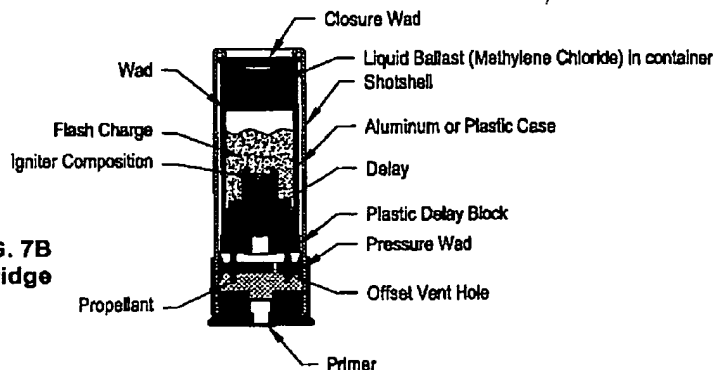


FIG. 7B
Projectile #4 in Cartridge

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As noted above, there are differences between these exemplary embodiments, but each has a weighty and frangible ballast located on the leading edge of the projectile, where the weight helps provide stability and accuracy in flight, and the frangibility results in the ballast becoming low mass, low energy fragments after the flash charge is detonated. Some of the differences between the exemplary embodiments include, but are not limited to, the following: projectile #1 has an aluminum case where the ballast is sealed in with a wad; projectile #2 has an obturator (to create a tighter fit with the interior of the cartridge) and does not have a wad in the interior of the projectile below the ballast; projectile #3 has a cardboard case with both lower and upper closure wads to seal in the ballast; and projectile #4 uses a liquid ballast in a nylon container at the front of the projectile.

On April 27, 2004, the Examiner issued a Restriction Requirement in which it was alleged that FIGS. 4A/4B, 5A/5B, 6A/6B, and 7A/7B were four patentably distinct species. The Restriction Requirement provides absolutely no argument or explanation supporting the Examiner's finding of four separate and distinct species, but rather merely repeats MPEP standard paragraph ¶8.01.

On May 27, 2004, the Response to the Restriction Requirement was filed, in which Species I (FIGS. 4A/4B) was elected and the requirement was traversed because the Examiner had failed to make a *prima facie* showing of a serious burden on the Examiner to examine the inventions (i.e., criteria (B) as stated in MPEP §803.01). No statement or argument was made concerning whether or not the species were independent or distinct. The Examiner was asked to reconsider the Restriction Requirement.

On September 13, 2004, an Office Action issued in which the Examiner acknowledged the traversal, but found the argument concerning no showing of a serious burden "not ... persuasive because as clearly shown in the Office Action dated 4/27/04 there are a plurality of patentably distinct species in the claimed invention" and also stated that "it is noted that an additional set of species would require additional searches and thus it would be a burden on the Examiner". The Requirement was made final. Claims 6, 10, 11, 16-19, 21, 30, 32, 33, and 35 were withdrawn from consideration by the Examiner.

The September 13, 2004 Office Action also indicated that dependent Claim 14 was in condition for allowance, if rewritten in independent form, including all the limitations of the base

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claim and any intervening claims. Dependent Claim 14 recited that the weighty and frangible ballast was a mixture of zinc and graphite, where the graphite coated the zinc particles.

On November 29, 2004, applicant filed an Amendment in which independent Claim 1 was amended to include the limitations of Claim 14 (and intervening Claim 13). Similar changes were made to the other pending independent claims. Thus, the independent claims recited a projectile with (a) a tubular projectile casing; (b) a delay block; (c) a delay fuse column; (d) a flash charge; and (e) a weighty and frangible ballast comprising zinc and graphite.

It should be noted that amended Claim 1 thus encompasses at least the projectiles shown in FIGS. 4A, 5A, and 6A above (although other substantially solid materials could also form the ballasts in those figures). Furthermore, as clearly contemplated by the claims as originally filed, the zinc and graphite ballast could be held by the container in FIG. 7A.

The November 29, 2004 Amendment noted that Claim 1, *as amended*, was generic to previously withdrawn Claims 10, 11, 18, 19, and 21. Claim 10 recites that the ballast is secured within the projectile by a wad (such as seen in FIG. 6A); Claim 11 recites that the projectile casing is cardboard with upper and lower wads around the ballast (such as seen in FIG. 6A); Claim 18 recites that a container holds the ballast; Claim 19 recites that the container of Claim 18 is made of nylon; and Claim 21 recites that there's an obturator on the outside of the projectile casing. As stated at MPEP §806.04(f), "...claims ... restricted to different species must recite *the mutually exclusive characteristics* of such species" (emphasis added). The very fact that any of Claims 10, 11, 18, 19, and 21 may depend from Claim 1 shows their limitations are not mutually exclusive to the limitations recited in amended Claim 1, i.e., Claim 1, as amended, does not recite a separate species from the species recited in any of Claims 10, 11, 18, 19, and 21, but is rather *generic* to all of those claims.

The November 29, 2004 Amendment also made similar arguments concerning the other amended independent claims and their previously withdrawn dependent claims, and added claims similar to previously withdrawn claims which were then canceled (for example, new Claim 39 comprised the limitations of previously withdrawn Claim 6, which was canceled without prejudice).

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On February 2, 2005, the Examiner issued a Final Rejection which maintained the withdrawn status of the previously withdrawn claims (and also withdrew some of the new claims which were based on previously withdrawn claims).

On page 3 of the February 2, 2004 Final Rejection, the Examiner writes the enigmatic sentence "[f]urther note that claim 1 (currently amended) is no longer a generic claim". No explanation, justification, and/or reasoning is given to support this conclusion.

POINTS TO BE REVIEWED

The Examiner's Initial April 27, 2004 Election of Species Requirement

There are two criteria for making a proper Restriction Requirement (see MPEP §803.01):

- (A) The inventions must be independent or distinct as claimed; and
- (B) There must be a serious burden on the Examiner to examine the inventions.

Applicant makes no comment or assertion concerning whether the Examiner has satisfied criteria (A); however, applicant traverses the Restriction Requirement because the Examiner has failed to make a *prima facie* showing of a serious burden, i.e., criteria (B). As stated in the MPEP, a serious burden may be *prima facie* shown by the Examiner "by appropriate explanation of separate classification, or separate status in the art, or a different field of search" (MPEP, §803.01). Because the Examiner has failed to show any of these, or even to make any statement concerning the serious burden criteria, the Examiner has not made a proper Restriction Requirement.

Furthermore, applicant asserts that examining all of the species shown by FIGS. 4A/4B, 5A/5B, 6A/6B, and 7A/7B would not be a serious burden. Although applicant makes no assertions concerning "separate classifications", applicant does assert that the "separate status in the art", if any, of the different species, and/or the "different fields of search", if any, required in order to examine the different species are not such as require an Election of Species.

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The Examiner's Lack of Support for the Election of Species Requirement

As stated above, the Examiner offered no support for the initial April 27, 2004 Election of Species Requirement and, when asked to reconsider, the Examiner asserted in the September 13, 2004 Office Action that "a plurality of patentably distinct species" was "clearly shown in the Office Action dated 4/27/04", plaintively adding that "an additional set of species would require additional searches and thus it would be a burden on the Examiner".

As also stated above, applicant asserts that the Examiner has not made a *prima facie* showing for a proper Restriction Requirement as explained in MPEP §803.01.

The Examiner's Finding that amended Claim 1 is not generic to the species recited in Claims 10, 11, 18, 19, and 21

In the February 2, 2004 Final Rejection, the Examiner notes "that claim 1 (currently amended) is no longer a generic claim" without providing any explanation or justification.

Amended Claim 1 is generic to each of Claims 10, 11, 18, 19, 21, 39, and 40, at least because Claim 1 does not "include limitations not present in each of the added species claims" or, in other words, dependent Claims 10, 11, 18, 19, 21, 39, and 40 "contain all the limitations of the generic claim" (MPEP §806.04(d)). Or, as argued above, the very fact that any of Claims 10, 11, 18, 19, and 21 may depend from Claim 1 shows their limitations are not mutually exclusive to the limitations recited in amended Claim 1, i.e., Claim 1, as amended, does not recite a separate species from the species recited in any of Claims 10, 11, 18, 19, and 21, but is rather *generic* to all of those claims.

Similar arguments can be made concerning all of the presently withdrawn claims in the instant application.

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ACTIONS REQUESTED

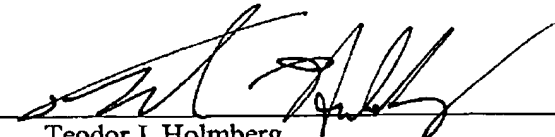
Based on the foregoing, applicant respectfully requests that:

the April 27, 2004 Election of Species Requirement be withdrawn; or^v
if not withdrawn, support for the Election of Species Requirement be provided;
and/or
the Examiner's finding that Claim 1 is not generic to all of the species claimed in the
presently withdrawn claims depending from Claim 1 be withdrawn; and/or
if not withdrawn, support for the Examiner's finding that amended Claim 1 is not
generic to all the species claimed in the presently withdrawn claims depending
from Claim 1.

Respectfully submitted,

COHEN, PONTANI, LIEBERMAN & PAVANE

By


Teodor J. Holmberg
Reg. No. 50,140
551 Fifth Avenue, Suite 1210
New York, New York 10176
(212) 687-2770

Dated: March 1, 2005

^v Obviously, if the Election of Species Requirement is withdrawn, the three remaining requested actions are no longer necessary. If the Election of Species Requirement is not withdrawn, applicant respectfully requests that all of the three remaining requested actions be considered.